

ESTTA Tracking number: **ESTTA161276**

Filing date: **09/07/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Naked Tequila Company
Granted to Date of previous extension	09/12/2007
Address	2 Lakeside Drive Falmouth, ME 04105 UNITED STATES
Attorney information	Julia Huston Bromberg & Sunstein LLP 125 Summer Street Boston, MA 02110 UNITED STATES jhuston@bromsun.com, pkarol@bromsun.com, ecoombs@bromsun.com Phone:617-443-9292

Applicant Information

Application No	78928660	Publication date	05/15/2007
Opposition Filing Date	09/07/2007	Opposition Period Ends	09/12/2007
Applicant	NakedJay Spirits Co., LLC 1209 Orange Street Corporation Trust Center Wilmington, DE 198011120 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Vodka
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	78481448	Application Date	09/10/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NAKED		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 033. First use: distilled spirits

U.S. Application No.	78134321	Application Date	06/10/2002
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NAKED TEQUILA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: Tequila made from Agave		

Attachments	78481448#TMSN.jpeg (1 page)(bytes) NAKEDJAY VODKA Notice of Opposition.pdf (4 pages)(12449 bytes)
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Signature	/Julia Huston/
Name	Julia Huston
Date	09/07/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application:

Serial No.: 78/928,660
Filed: July 13, 2006
Applicant: NakedJay Spirits Co., LLC
Mark: NAKEDJAY VODKA (plus design)
For: Vodka
Published: May 15, 2007

THE NAKED TEQUILA COMPANY,)	
)	
Opposer,)	
)	
v.)	<u>NOTICE OF OPPOSITION</u>
)	
NAKEDJAY SPIRITS CO., LLC)	
)	
Applicant.)	
_____)	

Sir or Madam:

The Naked Tequila Company (“Naked Tequila”), a partnership organized and existing under the laws of the State of Maine, composed of Gregory Caswell, USA and Lance Wieland, USA, and having its principal place of business at 2 Lakeside Drive, Falmouth, ME 04105, believes that it will be damaged by registration of the mark shown in Application Serial No. 78/928,660 (the “Application”), filed on July 13, 2006, and thus opposes that Application on the following grounds:

LIKELIHOOD OF CONFUSION

1. Application Serial No. 78/928,660, filed by NakedJay Spirits Co., LLC (“NakedJay”) on July 13, 2006, seeks registration of the mark NAKEDJAY VODKA

(plus design) (the “NAKEDJAY VODKA mark”) in connection with vodka, in International Class 33, based on NakedJay’s intention to use the mark in commerce.

2. As published, according to the application, the NAKEDJAY VODKA mark consists of a depiction of a bird with the words NAKEDJAY and VODKA. The bird's head, body, tail and legs are black. The bird's crest is blue. The word NAKED is black with black lining to the right and below each of the letters. The word JAY is blue with blue lining to the right and below each of the letters. The word VODKA is black. The white and gray in the drawing represents background, outlining, shading, and/or transparent areas and is not part of the mark.

3. On May 25, 2007, Naked Tequila was granted a 90-day extension of the time to oppose the Application for good cause until September 12, 2007.

4. On information and belief, NakedJay has never used the NAKEDJAY VODKA mark in connection with any goods or services.

5. On information and belief, NakedJay has never used the NAKEDJAY VODKA mark in commerce in connection with the goods described in the Application.

6. Naked Tequila is the owner of an intent-to-use application, App. Ser. No. 78/481,448 for the mark NAKED, which was filed on September 10, 2004 and allowed on November 15, 2005, for distilled spirits in International Class 33. Naked Tequila is also the owner of an intent-to-use application, App. Ser. No. 78/134,321 for the mark NAKED TEQUILA, which was filed on June 10, 2002 and allowed on August 2, 2005, for tequila made from Agave in International Class 33. Collectively, the marks claimed in these applications shall be referred to as “the NAKED Marks.”

7. Naked Tequila has a bona fide intention to use the NAKED Marks with the goods listed in the respective applications in the future.

8. Both of Naked Tequila’s applications for the NAKED Marks were filed before the Application was filed.

9. NakedJay's NAKEDJAY VODKA mark is confusingly similar to Naked Tequila's NAKED mark and Naked Tequila's NAKED TEQUILA mark. Vodka is the generic name for a type of distilled spirit. The dominant and distinctive feature of NakedJay's NAKEDJAY VODKA mark is thus the term NAKED, which feature is fully encompassed by both Naked Tequila's NAKED mark and Naked Tequila's NAKED TEQUILA mark. In addition, NakedJay's NAKEDJAY VODKA mark creates a similar overall commercial impression as that created by Naked Tequila's NAKED mark and Naked Tequila's NAKED TEQUILA mark.

10. The description of goods contained in the Application (vodka) and the goods that Naked Tequila intends to sell in connection with the NAKED Marks (distilled spirits) are identical goods, which directly overlap, and are sold through the same marketing channels to the same purchasers.

11. NakedJay's use and registration of the later filed and confusingly similar NAKEDJAY VODKA mark will cause purchasers, prospective purchasers, users, and others to be confused, mistaken, or deceived into the belief, contrary to fact, that NakedJay's goods emanate from or are sponsored or approved by Naked Tequila or are related to Naked Tequila's goods, thus damaging Naked Tequila.

WHEREFORE, The Naked Tequila Company prays that the present opposition be sustained and registration of the NAKEDJAY VODKA mark sought by NakedJay Spirits Co., LLC be refused.

The \$300 filing fee for this Notice of Opposition will be charged to Deposit Account No. 19-4972; please charge any additional fees that may be required to that account. This Notice of Opposition is being filed electronically.

All communications should be addressed to Opposer's counsel, Bromberg & Sunstein LLP, at the address below.

Dated: Boston, Massachusetts
September 7, 2007

THE NAKED TEQUILA COMPANY

By its attorneys,

/s/ Peter J. Karol

Julia Huston

Peter J. Karol

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